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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,327	09/26/2003	Christophe Boulle	231034US0	5081

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EXAMINER

COTTON, ABIGAIL MANDA

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 03/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/670,327	Applicant(s) BOULLE ET AL.	
	Examiner Abigail M. Cotton	Art Unit 1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 24-29 is/are pending in the application.
- 4a) Of the above claim(s) 3 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-15 and 24-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/9/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office Action is in response to the amendment submitted on January 9, 2006. Claims 1-15 and 24-29 are pending in the application, with claim 3 having been withdrawn, claims 16-23 having been canceled, and claims 24-29 having been newly added. Accordingly, claims 1-2, 4-15 and 24-29 are being examined on the merits herein.

Response to Amendment

The declaration filed on January 9, 2006 under 37 CFR 1.131 has been considered but is ineffective to overcome the Gul et al. reference.

The Examiner notes that an affidavit or declaration under 37 CFR 1.131 must be made by a party qualified under 37 CFR 1.42, 1.43 or 1.47, i.e. all of the inventors of the claimed subject matter, or the assignee or other party in interest when it is not possible to produce the affidavit or declaration of the inventor. See MPEP §715.04. The instant declaration is signed only by one of the three co-inventors of the application, namely Christophe Boulle. Accordingly, the declaration does not meet the requirements for establishing prior invention under 37 CFR 1.131 and is not effective to overcome the Gul et al. reference.

The Examiner furthermore notes that evidence is required to establish both conception and reduction to practice of the claimed invention in this country or a NAFTA or WTO member country prior to the effective date of the Gul et al. reference in order to overcome the reference. The evidence submitted is insufficient to establish a reduction to practice of the invention, because the evidence refers only to the conception of the invention (see points 2-3 of the declaration), and does not establish when reduction to practice of the invention occurred with respect to the effective date of the Gul et al. reference.

The declaration is furthermore ineffective because the scope of the declaration is not commensurate with the scope of the claims. The Examiner notes that when a reference discloses a claimed genus, a showing of completion of a single species within the genus is generally not sufficient to antedate the reference under 37 CFR 1.131 when predictability is in question. See MPEP §715.02. The chemical and pharmaceutical arts are known to be unpredictable arts. The Gul et al. reference discloses a series of compounds having antifungal activity that fall within the limitations of the claims (see Table 1, compounds B1-B5, in particular.) The instant declaration provides notebook pages describing the potential use of a single particular compound, namely the compound B1 as described by Gul et al, as an anti-wrinkle agent. Thus, Applicant's declaration does not provide sufficient evidence to show possession of the generic claim before the effective date of the Gul et al. reference.

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The Examiner notes that if the declaration would be sufficient to overcome the Gul et al. reference with regards to the particular species of compound recited in claim 9, if the declaration was re-submitted in proper form establishing both conception and reduction to practice prior to the effective date of the Gul et al. reference, and signed by all inventors of the claimed invention.

Applicant's arguments filed January 9, 2006 regarding the rejections of the claims over the prior art have been fully considered but they are not persuasive.

The claims are rejected as follows.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 4-15 and 24-29 are rejected under 35 U.S.C. 103(a) as being obvious over U.S. Patent No. 6,641,824 to Duggan et al, issued November 4, 2003, in view of the article entitled "Antifungal Evaluation of Bis Mannich Bases Derived from

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Acetophenones and Their Corresponding Piperidinols and Stability Studies" by Gul et al, Biol. Pharm. Bull. 25 (10) 1307-1310, October 2002.

Duggan et al. teaches applying a topical application to skin to improve the aesthetic appearance, and particularly to treat and/or reduce fine lines and wrinkles, that comprises a retinoid (see abstract, in particular.) Duggan et al. furthermore teaches that the compositions can comprising additional ingredients including antifungals (see column 4, lines 54-62, in particular.)

Regarding claim 11, Duggan teaches that ingredients provided in the wrinkle treatment composition can comprise antioxidants that scavenge free radicals from the skin (see column 4, lines 33-54, in particular.) Regarding claims 12-15, Duggan et al. teaches the composition can be applied to facial lines and/or wrinkles to improve the appearance thereof, such as on the forehead and/or around the mouth, and diminishes the appearance of the wrinkles, and improves the appearance of suborbital and/or periorbital lines and crow's feet (see column 3, lines 8-30, in particular.)

Duggan et al. does not specifically teach providing the compound corresponding to the elected species of formula (Ia).

Gul et al. teaches that Bis Mannich bases have antifungal activity (see abstract.) Gul et al. teaches that testing of a Bis Mannich base (compound number B1) having the

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chemical formula that corresponds to Ia shows antifungal activity against dermatophytes (see Table 1 and Conclusions, in particular), which are fungi that are parasitic on skin. The Bis Mannich base number B1 as taught by Gul et al. meets the limitations of claims 1-2, 4-9 and 24.

Accordingly, one of ordinary skill in the art at the time the invention was made would have found it obvious to provide the Bis Mannich base of Gul et al. in the wrinkle treatment composition of Duggan et al, because Duggan et al. teaches that the wrinkle treatment composition can comprise an antifungal, and Gul et al. teaches that the compound represented by formula (Ia), which corresponds to the elected species, has antifungal activity against fungi that attack the skin. Thus, one of ordinary skill in the art would have been motivated to provide the antifungal of Gul et al. in the topical composition of Duggan et al, with the expectation of providing a wrinkle treatment composition that also has antifungal activity against fungi that attack skin. Thus, claims 1-2, 4-9 and 24 are obvious over the teachings of Duggan et al. and Gul et al.

Regarding claims 10 and 25-29, it is considered that one of ordinary skill in the art would find it obvious to vary and/or optimize the percent weight of the antifungal in the compositions to provide the desired antifungal effects, in accordance with the guidance provided by Duggan et al. and Gul et al. It is noted that "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the

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optimum or workable ranges by routine experimentation." In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955.)

Response to Arguments

Applicant's arguments filed January 9, 2006 have been fully considered but they are not persuasive. In particular, Applicant's assert possession of the claimed invention before the effective date of the Gul et al. reference, and thus argue that the Gul et al. reference is overcome. However, the Examiner respectfully notes that the declaration submitted under 37 CFR 1.131 is not sufficient to overcome the Gul et al. reference for the reasons as discussed, and thus the claims remain rejected over the cited references.

Conclusion

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Abigail M. Cotton whose telephone number is (571) 272-8779. The examiner can normally be reached on 9:30-6:00, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AMC



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SUPERVISORY PATENT EXAMINER